

### **REMARKS**

This is a full and timely response to the outstanding non-final office action dated December 23, 2008. Through this response, claims 75-79, 82, 84, 88-91, and 92-93 have been amended to further clarify the claim scope, and claims 95-99 have been newly added without the introduction of new matter. Reconsideration and allowance of the application and pending claims 75-99 are respectfully requested.

#### **I. Amendments to the Specification**

As set forth above, Applicants have amended the title, replacing the previous title with the following:

Graphic User Interfaces for Purchasable and Recordable Media (PRM) Downloads

Applicants respectfully request entry of the replacement title.

#### **II. Claim Rejections - 35 U.S.C. § 103(a)**

##### **A. Statement of the Rejection**

Claims 75-81, 83, 84, 92, and 93 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* (U.S. Pat. No. 6,557,030) in view of *Kusaba et al.* ("*Kusaba*," U.S. Pat. No. 6,510,556), *Lett et al.* ("*Lett*," U.S. Patent No. 5,592,551), and *Hicks, III et al.* ("*Hicks*," U.S. Pat. Public. No. 20040261112).

Claim 82 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, and further in view of *Okamoto et al.* ("*Okamoto*," U.S. Pat. No. 6,901,385).

Claims 85-87 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, and further in view of *Ellis et al.* ("*Ellis*," U.S. Pat. Public. No. 20030188313).

Claims 88-90 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, and further in view of *Hunter et al.* ("*Hunter*," U.S. Pat. Public. No. 20020056118).

Claim 91 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, and *Hunter*, and further in view of *Philips* (U.S. Pat. Public. No. 20020069412) and *Tomita et al.* ("*Tomita*," U.S. Pat. No. 6,732,372).

Claim 94 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hunter* in view of *Tomita*.

Applicants respectfully traverse these rejections to the extent not rendered moot by amendment.

#### **B. Discussion of the Rejection**

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

For a proper rejection of the claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements / features of the claim at issue. See, e.g., *In re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988) and *In re Keller*, 208 U.S.P.Q.2d. 871, 881 (C.C.P.A. 1981).

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

Claims 75-81, 83, 84, 92, and 93 – Hoang, Kusaba, Lett and Hicks

**Independent Claim 75**

Claim 75 recites (with emphasis added):

75. A system comprising:  
a digital home communication terminal (DHCT) configured to receive media content from a remote location over a network, the DHCT comprising:  
***a hard disk drive;***  
***a memory*** having application software; and  
a processor configured with the application software to ***provide a first graphics user interface (GUI) comprising download options for the reception of purchasable and recordable media (PRM) content and a second GUI comprising plural media content choices for which the download options do and do not pertain, the PRM content comprising content that is purchased one-time for indefinite use,***  
the processor further configured with the application software to request from the remote location a download of a first ***PRM content*** to the hard disk drive the ***first PRM content selected by a user from the second GUI.***

Applicants respectfully submit that the amendments to claim 75 have rendered the rejection moot. Further, Applicants respectfully submit that independent claim 75 is allowable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks* for at least the reason that *Hoang* in view of *Kusaba*, *Lett*, and *Hicks* fails to disclose, teach, or suggest at least the above emphasized claim features. The Office Action (page 3) incorrectly recites the same component in *Hoang* (memory 308) to reject two separate and distinguishable features

(**hard disk drive** and **memory**) of claim 75. For at least this reason, the rejection is insufficient.

In addition, acknowledging (page 3 of the Office Action) that *Hoang* does not disclose the claimed GUI features, the Office Action relies on *Kusaba* to reject these GUI features. Claim 75 now recites PRIM content, which neither *Hoang*, *Kusaba*, or *Lett* describe or suggest. It is noted that *Hicks* makes brief mention of an option to purchase a copy of a movie for personal possession (see, e.g., paragraph [0025]), but even assuming *arguendo* that such disclosure can be considered PRIM content, *Hicks* offers no enabling disclosure on the mechanisms to achieve such functions.

Further, the combination of *Hoang* and *Kusaba* is not obvious. *Kusaba* introduces a system that represents an alternative architecture to conventional VOD due to the alleged cost constraints imposed by VOD (see, e.g., col.1, lines 51-52, and col. 8, lines 58-65, *Kusaba*). Hence, it is not obvious to modify *Hoang* with the completely different system of *Kusaba*, especially when *Kusaba* teaches away from conventional VOD architectures. As set forth in well-established case law, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In short, one would not be motivated to use a system that teaches away from VOD for use in a VOD system.

For at least the reasons presented above, Applicants respectfully request that the rejection be withdrawn.

Because independent claim 75 is allowable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, dependent claims 76-81, 83, and 84 are allowable as a matter of law for at least the reason that the dependent claims 76-81, 83, and 84 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Applicants respectfully submit that one or more of the dependent claims are allowable on separate grounds, even beyond the fact that the rejections are rendered moot by the amendment corresponding to PRM content. For instance, with regard to claim 76, the Office Action (page 6) alleges that Figure 13 of *Lett* discloses a download option list, and a selectable option to “download the first media content immediately (e.g. Once).” Applicants respectfully disagree. ***Immediately*** does not equate to “once.” For instance, once can be hours in the future, especially given the fact that PPV is typically a scheduled service.

#### Independent Claim 92

Claim 92 recites (with emphasis added):

92. A method, comprising:  
providing a first graphics user interface (GUI) at a digital home communications terminal (DHCT), ***the first GUI comprising download options for the reception of purchasable and recordable media (PRM) content, the PRM content comprising content that is purchased one-time for indefinite use;***  
***providing a second GUI at the DHCT, the second GUI comprising plural media content choices for which the download options do and do not pertain;*** and  
requesting a download of a first ***PRM content*** from a remote location to a hard disk drive coupled to the DHCT at a defined download rate, the ***first PRM content selected by a user from the second GUI.***

Applicants respectfully submit that the amendments to claim 92 have rendered the rejection moot. Further, Applicants respectfully submit that independent claim 92 is allowable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks* for at least the reason that *Hoang* in view of *Kusaba*, *Lett*, and *Hicks* fails to disclose, teach, or suggest at least the above emphasized claim features. Acknowledging (page 3 of the Office Action) that *Hoang* does not disclose the claimed GUI features, the Office Action relies on *Kusaba* to reject these GUI features. Claim 92 now recites PRM content, which neither *Hoang*,

*Kusaba*, or *Lett* describe or suggest. It is noted that *Hicks* makes brief mention of an option to purchase a copy of a movie for personal possession (see, e.g., paragraph [0025]), but even assuming *arguendo* that such disclosure can be considered PRM content, *Hicks* offers no enabling disclosure on the mechanisms to achieve such functions.

Further, the combination of *Hoang* and *Kusaba* is not obvious. *Kusaba* introduces a system that represents an alternative architecture to conventional VOD due to the alleged cost constraints imposed by VOD (see, e.g., col.1, lines 51-52, and col. 8, lines 58-65, *Kusaba*). Hence, it is not obvious to modify *Hoang* with the completely different system of *Kusaba*, especially when *Kusaba* teaches away from conventional VOD architectures. As set forth in well-established case law, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In short, one would not be motivated to use a system that teaches away from VOD for use in a VOD system.

For at least the reasons presented above, Applicants respectfully request that the rejection be withdrawn.

Because independent claim 92 is allowable over *Hoang* in view of *Kusaba*, *Lett*, and *Hicks*, dependent claim 93 is allowable as a matter of law.

Claim 82- *Hoang*, *Kusaba*, *Lett*, *Hicks*, and *Okamoto*

The addition of *Okamoto* does not cure the deficiencies of *Hoang*, *Kusaba*, *Lett*, *Hicks* discussed above in connection with independent claims 75. Therefore, for at least the reason that claim 75 is allowable over *Hoang*, *Kusaba*, *Lett*, *Hicks*, and *Okamoto*, dependent claim 82 is allowable as a matter of law. Therefore, Applicants respectfully request that the rejection of claim 82 be withdrawn.

Claims 85-87 - *Hoang Kusaba, Lett, and Hicks, and Ellis*

The addition of *Ellis* does not cure the deficiencies of *Hoang, Kusaba, Lett, Hicks* discussed above in connection with independent claims 75. Therefore, for at least the reason that claim 75 is allowable over *Hoang, Kusaba, Lett, Hicks, and Ellis*, dependent claims 85-87 are allowable as a matter of law. Therefore, Applicants respectfully request that the rejection of claims 85-87 be withdrawn.

Applicants respectfully submit that one or more of the dependent claims are allowable on separate grounds, even beyond the fact that the rejections are rendered moot by the amendment corresponding to PRM content. For instance, with regard to claim 85, the Office Action (page 9) alleges that *Ellis* discloses the features of claim 85, namely, “wherein the second GUI comprises an interactive program guide (IPG) with access by the user to a service guide via a service guide option.” Applicants respectfully disagree. Paragraph 0133, cited by the Office Action, notes that the menu is launched from a browse or flip mode (figures 13 and 5, respectively), neither of which may be considered an IPG as claimed. Accordingly, Applicants respectfully request that the rejection to claims 85-87 be withdrawn on these additional and separate grounds.

Claims 88-90 – *Hoang, Kusaba, Lett, Hicks, and Hunter*

The addition of *Hunter* does not cure the deficiencies of *Hoang, Kusaba, Lett, Hicks* discussed above in connection with independent claims 75. Therefore, for at least the reason that claim 75 is allowable over *Hoang, Kusaba, Lett, Hicks, and Hunter*, dependent claims 88-90 are allowable as a matter of law. Therefore, Applicants respectfully request that the rejection of claims 88-90 be withdrawn.

Claim 91 – Hoang, Kusaba, Lett, and Hicks, Hunter, Philips and Tomita

The addition of *Hunter, Philips* and *Tomita* does not cure the deficiencies of *Hoang, Kusaba, Lett, Hicks* discussed above in connection with independent claims 75. Therefore, for at least the reason that claim 75 is allowable over *Hoang, Kusaba, Lett, Hicks, Hunter, Philips* and *Tomita*, dependent claim 91 is allowable as a matter of law. Therefore, Applicants respectfully request that the rejection of claim 91 be withdrawn.

Claim 94 – Hunter and Tomita

Claim 94 recites (with emphasis added):

94. A system, comprising:  
a storage device comprising one of a digital video disk (DVD) or compact disk (CD);  
a tuner configured to receive broadcast or on-demand media content;  
a memory with application software; and  
a processor configured with application software to provide **a graphics user interface (GUI) that enables a user to archive broadcast or on-demand media content downloaded to one of the DVD or CD, the broadcast or on-demand media content archived based on metadata associated with the broadcast or on-demand media content, the GUI further configured to enable the user to search for media content stored on the DVD or CD.**

Applicants respectfully submit that independent claim 94 is allowable over *Hunter* in view of *Tomita* for at least the reason that *Hunter* in view of *Tomita* fails to disclose, teach, or suggest at least the above emphasized claim features. The Office Action (page 13) alleges that *Hunter* teaches the features of archiving based on metadata associated with the broadcast or on-demand media content. Applicants respectfully disagree. Applicants respectfully request assistance in determining where in *Hunter* it is allegedly taught that the archive is based on the meta data (rather than merely downloaded without any predefined guidance based on meta data). In addition, the Office Action (page 13) alleges that *Tomita* remedies the deficiency in *Hunter* with regard to the search features.



Applicants respectfully disagree. There is nothing in *Tomita* to suggest a search is performed by a user (as assisted by the processor) on a DVD or CD. For at least these reasons, Applicants respectfully request that the rejection be withdrawn.

### **III. New Claims**

As identified above, claims 95-99, features of which were previously incorporated in independent claims 75 and 92, have been recast as dependent claims. For at least the reasons that each dependent claim depends from an allowable independent claim, claims 95-99 are allowable as a matter of law.

In addition, one or more of the dependent claims are allowable on separate and independent grounds. For instance, with regard to claim 95, the Office Action (page 4) alleges that *Kusaba* (Figures 4C-4E) teaches “using bandwidth reclaimed from excess video on demand bandwidth.” Applicants respectfully disagree. There is nothing to suggest that any content was downloaded from the “open time slots.” Accordingly, Applicants respectfully request that the rejection to claims 95 (and 98) be withdrawn on these separate grounds.

**CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/David Rodack/

David Rodack  
Registration No. 47,034

Merchant & Gould P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
404.954.5100